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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,408	03/27/2000	KLAUS MALER	112740-421	3860

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT PAPER NUMBER

2685

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,408

Applicant(s)

Klaus Maler

Examiner

Naghmeh Mehrpour

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2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 27, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11 6) ☐ Other:

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 7-8**, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **Claims 7-8**, the limitation “*control means for allocating a network address to the recognized to communication system under which the communication terminal apparatus can currently be reached and communicating control information via the selected base station to a control network address for influencing an activation/deactivation condition related to another communication system not having the selected base station the control network address being stored in a memory, of the communication terminal apparatus, wherein the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached*” on page 1 in claim 7 lines 7-14, and on page 2 in claim 8 lines 8-14, is indefinite, it is not clear why the network address being stored in a memory of the mobile, in order for controller to select another network that is not currently used. Therefore correction are required.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 7-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ault et

al.(US Patent 5,754,542) in view of Nishida (US Patent Number 5,995,828).

Regarding **Claims 7-8**, Ault teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (Column 1 lines 39-46), the communication terminal apparatus being logged on as ready to receive the selected base station, the communication terminal apparatus comprising: recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station (Column 2 lines 5-9); and control means for allocating a network address to the recognized to communication system under which the communication terminal apparatus can currently be reached and communicating control information via the selected base station for influencing an activation/deactivation condition related to another communication system not having the selected base station (Column 4 lines 24-31, Column 5 lines 5-39). Ault fails to teach **wherein the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached. However**

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Nishida teaches a method wherein a communication system move from one network to another network, for identifying each network, uses the network address. Nishida system having the first network address for receiving telephone calls from the first base station in the first communication zone and a second network address different from the first address network for receiving telephone calls from the second base station in the second communication zone (column 11 lines 30-45). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to provide above teaching of Nishida to Ault, in order to enable the user to establish communication between different networks.

Regarding **Claims 9-10**, Ault teaches a communication terminal apparatus wherein the control information activates a call redirection relating to a subscriber address under which the communication terminal apparatus can be reached via another communication system not having the selected base station, given corresponding readiness to receive the another communication system by the communication terminal apparatus (Column 2 lines 14-25).

Regarding **Claim 11**, Ault teaches a communication terminal apparatus wherein the memory stores a control network address of a mobility server (Column 4 lines 15-18).

Regarding **Claim 12**, Ault teaches a communication terminal apparatus wherein the memory stores a plurality of control network addresses of a plurality of communication systems, and the communication terminal apparatus further comprising: selection means for selecting at least one control network address of another communication system not having the selected base station (Column 2 lines 15-25).

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Response to Arguments

5. Applicant's arguments with respect to claims 7-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. **Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 308-6306, (for informal or draft communications, please label

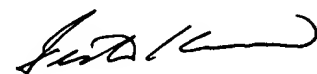
“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Va., sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

NM

OCT 1, 2002



**LESTER G. KINCAID
PRIMARY EXAMINER**